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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,474	03/29/2001	Takumi Tanabe	8861-400US (P23811-01)	5649

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

RAMAN, USHA

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/820,474	Applicant(s) TANABE ET AL.	
	Examiner Usha Raman	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 19<sup>th</sup>, 2005 has been entered.

***Response to Arguments***

2. Applicant's arguments filed October 19<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

Applicant argues that Wu provides no control of the video content by the broadcast receiver. The examiner also notes applicant's arguments regarding Dunn's use of a remote control for controlling the playback of the video content, the playback controls are relayed from the receiver to the broadcast station, thereby the receiver instructing to the broadcast station to control the playback of the content. Applicant also argues that Dunn's pause and resume operation teaches away the modified system of Wu et al. because Wu teaches concurrent display of video content and advertisement content. The examiner respectfully disagrees. Wu also teaches the step of toggling back and forth between the advertisement and the TV viewing, wherein the need for stop the TV video briefly arises due to another application being active, thus taking the user's attention away from the TV video.

The viewer can resume the TV video after viewing the advertisement, thereby not missing anything on the TV program.

As a result, the examiner maintains rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (US Pat. 6,326,982) in view of Broadwin et al. (US Pat. 5,903,816) and further in view of Dunn et al. (US Pat. 5,517,257).

Regarding apparatus claim 1 and method claim 7, Wu teaches a broadcast system comprising a broadcast station and a television broadcast receiver connected to said broadcast station by a two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16, Dedicated Server Providing TV Programming Schedule/Web Address Mapping information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way channel. Video Data Provider and Internet can both be connected to Web/TV through a cable network therefore the Video Data Provider and the Server are equivalent to a broadcast station), wherein said television broadcast receiver comprises a browser unit for reproducing display data coded by the Hyper Text Markup Language (See Fig. 2 Processor 56 and Video Processor 92 and Col. 4 lines 18-39 and Col. 5 lines 5-55 Processor and

Video Processor display HTML coded data). Wu teaches that when the browser is active, the processing unit generates video signal representing the activities of the web browser that is fed into the video display processor. See column 5, lines 40-44. The browser therefore instructs the reproduction control unit to display the contents of the web browser when it is active. Wu further teaches the receiver comprising a storage unit (See Fig. 2 Memory Unit 76 Col. 4 lines 40-56) and wherein said broadcast station transmits prior to or during the transmission of contents an advertising scenario header for at least instructing what kind of advertising information should be reproduced and in what way (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43, Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information is downloaded to the receiver, wherein the information tells the receiver which web pages to access during content transmission. Web pages can include advertisement information. Therefore, programming schedule mapping information is equivalent to advertising scenario header), and also instructing how said contents should be reproduced in accordance with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and during the reception and reproduction of said contents said television broadcast receiver reproduces said advertising information by means of said browser unit in accordance with the contents of said advertising scenario header received from said broadcast station (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col. 11 lines 18-67, and Col. 12 lines 1-60). Wu fails to

disclose where HTML advertisement is stored in the memory and the browser Unit reproduces advertisement information stored in memory. Having a television receiver store interactive programming data in memory for reproduction during the transmission of content is well known in the art as taught by Broadwin (See Fig. 8 Step 444, Abstract and Col. 11 lines 37-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wu's invention so that the receiver stored advertisement information in memory and the browser unit reproduced advertisement information from memory as taught by Broadwin so that advertisement information could be provided more quickly, thus reducing latency and providing greater responsiveness (See Broadwin Col. 3 lines 12-16).

Wu as modified with Broadwin teaches wherein said television broadcast receiver comprises a reproduction control unit for controlling the reproduction of said contents (See Wu Col. 5 lines 44-47 Toggling between a web browser and TV viewing is controlling reproduction). Wu and Broadwin differs from the claimed invention in that the television broadcast receiver does not instruct the broadcast station through said reproduction control unit to temporarily stop the transmission of said contents when starting the reproduction of said advertising information during the reception and reproduction of said contents, and instructs said broadcast station through said reproduction control unit to restart the transmission of said contents when ending the reproduction of said advertising information. However, a receiver with a control unit that can instruct a broadcast station to temporarily stop and

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resume the transmission a contents is well know in the art as taught by Dunn (See Col. 7 lines 63-67 and Col. 8 lines 1-31). Therefore, it would have been obvious to one of ordinary skill in the art to further modify Wu and Broadwin's reproduction control unit so that it gave the user the ability to temporarily stop the transmission of content when accessing advertisement information and the ability to resume transmission of content as taught by Dunn in order to assist the viewer in controlling the viewing of the contents transmitted from the server (See Dunn Col. 1 lines 55-56).

### ***Conclusion***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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